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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,752

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Toshiyuki Aritake

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EXAMINER

KUGEL, TIMOTHY J

ART UNIT

PAPER NUMBER

1796

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/540,752	Applicant(s) ARITAKE, TOSHIYUKI	
	Examiner Timothy J. Kugel	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/24/2004 & 02/03/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 1-9 are pending as amended on 24 June 2005.

Priority

2. Receipt is acknowledged of papers submitted under 35 USC 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The information disclosure statements submitted on 24 June 2005 and 3 February 2006 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statements.

Specification

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
- 5.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 USC 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 2-9 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, the inclusion of a term within parentheses—with the exception of those parentheses necessary for chemical or mathematical formulae—renders the claim indefinite because it is unclear whether the included term is part of the claimed invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-3, 5 and 7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 4 of copending Application 10/565,532.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims a biaxially stretched aliphatic polyester film and a method of forming such a film—which would result in an article as instantly claimed—wherein the sheet comprises an amorphous polylactic acid resin and a crystalline polylactic resin wherein the amount amorphous resin in one layer is greater than that of the crystalline resin and therefore reads on the instant limitation 'present in an amount of more than 50% of said crystalline polylactic acid polymer, and wherein the ratio of D-lactic acid to L-lactic acid in the amorphous polylactic acid ranges from 10:90 to 90:10 and the ratio of D-lactic acid to L-lactic acid in the crystalline polylactic acid ranges from 0.5:99.5 to 6:94 or from 99.5:0.5 to 94:6.

Pertaining specifically to claims 3 and 7, since the copending application claims the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the ΔH_m and ΔH_c —and therefore the relationships between the ΔH_m and ΔH_c —of the copending composition would inherently be the same as claimed. If there is any difference between the product of the copending claims and the product of the instant claims the difference would have been minor and obvious.

Further, claims 5 and 7 are viewed as product-by-process claims and hence the methods they are created by are not pertinent, unless applicant can show a different

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product is produced. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented, although the copending application is set to issue as US Patent 7,390,558, at which time this rejection will become non-provisional.

Claim Rejections - 35 USC § 102 and/or 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 USC 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 USC 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 1, 2, 4 and 6 are rejected under 35 USC 102(b) as being anticipated by Japanese Patent Publication JP 2000-017163 (Fuji hereinafter). Fuji was cited as an X-type reference on the European Search Report for EP 03786292, which claims priority to the same foreign application as the instant application. Citations below come from a machine translation of Fuji, a copy of which is included with this action.

Fuji teaches a polylactic acid composition, sheet and articles formed from said sheet (¶¶0002 and 0020), wherein said composition comprises 10:90 to 90:10 of polymer (A):polymer (B), wherein polymer (A) is a crystalline polymer of from 70-95 mole percent L-lactic acid, from 5-30 mole percent of a copolymerization component—which can form aliphatic polyesters other than those from lactic acid—including aliphatic polyester forming monomers such as hydroxybutyric acid as instantly exemplified—and the remainder D-lactic acid and the polymer (B) is an amorphous polymer of from 70-95 mole percent D-lactic acid, from 5-30 mole percent of a copolymerization component—including aliphatic polyester forming monomers such as hydroxybutyric acid as instantly exemplified—and the remainder L-lactic acid (¶¶0022-0030).

9. Claims 1, 2, 4 and 6 are rejected under 35 USC 102(b) as being anticipated by Japanese Patent Publication JP 2002-155197 (Tanide hereinafter). Tanide was cited as an X-type reference on the International Search Report for PCT/JP03/16642, from which the instant application is a national stage entry. Citations below come from a machine translation of Tanide, a copy of which is included with this action.

Tanide teaches a polylactic acid composition, sheet and articles formed from said sheet (¶0029), wherein said composition comprises 50-99.9 mass percent polylactic acid wherein polylactic acid of high crystallinity comprises at least 20% and preferably more than 50 mass percent and has an L-form to D-form ratio of not lower than 95:5 and not higher than 5:95 (Abstract and ¶0012) and wherein the polylactic acid may be copolymerized with other aliphatic polyester forming monomers—including hydroxybutyric acid as instantly exemplified (¶0009).

10. Claims 3, 5 and 7-9 rejected under 35 USC 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as being unpatentable over Fuji.

Fuji teaches a polylactic acid composition, sheet and articles formed from said sheet, wherein said composition comprises 10:90 to 90:10 of polymer (A):polymer (B), wherein polymer (A) is a crystalline polymer of from 70-95 mole percent L-lactic acid, from 5-30 mole percent of a copolymerization component—which can form aliphatic polyesters other than those from lactic acid—and the remainder D-lactic acid and the polymer (B) is an amorphous polymer of from 70-95 mole percent D-lactic acid, from 5-30 mole percent of a copolymerization component—which can form aliphatic polyesters other than those from lactic acid—and the remainder L-lactic acid as detailed above.

Pertaining specifically to claims 3, 6, 7 and 9, since Fuji teaches the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the ΔH_m and ΔH_c —and therefore the relationships between the ΔH_m and ΔH_c —of the Fuji composition would inherently be the same as

claimed. If there is any difference between the product of Fuji and the product of the instant claims the difference would have been minor and obvious.

Claims 5 and 7-9 are viewed as product-by-process claims and hence the methods they are created by are not pertinent, unless applicant can show a different product is produced. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 USC 102 and 103. "There is nothing inconsistent in concurrent rejections for obviousness under 35 USC 103 and for anticipation under 35 USC 102." *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977).

11. Claims 3, 5 and 7-9 rejected under 35 USC 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as being unpatentable over Tanide.

Tanide teaches a polylactic acid composition, sheet and articles formed from said sheet, wherein said composition comprises 50-99.9 mass percent polylactic acid wherein polylactic acid of high crystallinity comprises at least 20% and preferably more

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than 50 mass percent and has an L-form to D-form ratio of not lower than 95:5 and not higher than 5:95 and wherein the polylactic acid may be copolymerized with other aliphatic polyester forming monomers—including hydroxybutyric acid as instantly exemplified.

Pertaining specifically to claims 3, 6, 7 and 9, since Tanide teaches the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the ΔH_m and ΔH_c —and therefore the relationships between the ΔH_m and ΔH_c —of the Tanide composition would inherently be the same as claimed. If there is any difference between the product of Tanide and the product of the instant claims the difference would have been minor and obvious.

Claims 5 and 7-9 are viewed as product-by-process claims and hence the methods they are created by are not pertinent, unless applicant can show a different product is produced. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 USC 102 and 103. "There is nothing inconsistent in concurrent

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rejections for obviousness under 35 USC 103 and for anticipation under 35 USC 102."

In re Best, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977).

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached 6:00 AM – 4:30 PM Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Timothy J. Kugel/
Patent Examiner, AU 1796